

REMARKS

1. In response to the Office Action mailed April 28, 2010, Applicants respectfully request reconsideration. Claims 30-55 were last presented for examination. In the outstanding Office Action, claims 30-55 were rejected. By the foregoing Amendments, no claims have been cancelled or added, and claim 51 has been amended. Thus, upon entry of this paper, claims 30-55 will be pending in this application. Of these twenty-six (26) claims, two (2) claims (claims 30 and 50) are independent.
2. Based upon the following Remarks, Applicants respectfully request that all outstanding objections and rejections be reconsidered, and that they be withdrawn.

Claim Rejections Under 35 USC § 112

3. Claims 30-55 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicants traverse this rejection.
4. The Office Action asserts that “Applicant’s preamble recites a device for testing components of a medical device but the body of the claim fails to recite any structure that tests the device.” (Office Action, page 2, second paragraph.) However, the Office Action does not cite any statute, regulation, case law or MPEP section in support of its assertion.
5. Applicants rely on MPEP §2173.04, entitled “*Breadth Is Not Indefiniteness.*” (Emphasis added.) MPEP section 2173.04, states that the

[b]reath of a claim is not to be equated with indefiniteness. *In re Miller*, 441 F.2d 689, 169 USPQ 597 (CCPA 1971). If the scope of the subject matter embraced by the claims is clear, and if applicants have not otherwise indicated that they intend the invention to be of a scope different from that defined in the claims, then the claims comply with 35 U.S.C. 112, second paragraph.

(MPEP §2173.02, emphasis added.) In this case, the scope of the subject matter embraced by the claims is clear. The Office Action does not assert otherwise. Further, Applicants have not otherwise indicated that they intend the invention to be of a scope different from that defined in

the claims. The Office Action likewise does not assert otherwise. Accordingly, a *prima facie* case of indefiniteness has not been established and the rejection should be withdrawn.

6. Further, the Office Action asserts that “Applicant’s claims merely have stations in which the device can be connected and have currents passed through but have no elements for evaluating whether the device is operational or not.” (Office Action, page 2, second paragraph.) Applicants disagree.

7. Claim 30, for example, recites “a plurality of cable testing stations,” a “coil testing station,” and “a testing circuit.” Claim 50, for example, recites “driving, with a testing circuit, the cable and transmitter coil via a first cable testing station so as to induce a voltage in a receiver coil . . .” and “driving, with the testing circuit, a test signal.” Applicants’ specification provides examples, including figures, of components corresponding by way of exemplary embodiment to elements recited in claim 30, and details how these components may be used to test components of a medical device.

8. In view of the just recited elements, far from “merely hav[ing] stations in which the device can be connected,” as is asserted in the Office Actions, the claims recite various test stations and methods including the use of a test signal. In view of this, it is clear that the rejections under 35 U.S.C. §112, second paragraph, are not consistent with proper PTO procedures. The alleged indefiniteness of a claim is not measured by the perceptions of an individual examiner. Rather, the standard is that of the skilled artisan, informed by the disclosure and the prior art. (See MPEP §2173.02.) Specifically, MPEP §2173.02 states that definiteness of claim language **must be analyzed, not in a vacuum**, but in light of:

- (A) The content of the particular application disclosure;
- (B) The teachings of the prior art; and
- (C) The claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made.

(MPEP §2173.02, emphasis added.)

9. It is respectfully submitted that the claim phrases in the independent claims are definite, and provide sufficient structure to the claim, once those claims are read in view of Applicants’

disclosure, the teachings of the prior art, and the interpretation given to those claim phrases by one possessing the ordinary level of skill in this art.

10. Also, the Office Action ignores dependent claim 49, which recites that the “testing circuit is configured to induce a voltage in the receive coil, and to determine whether a smoothed voltage corresponding to the induced voltage falls within a design specification range for the transmitter coil.” The Office Action also ignores dependent claim 51, which recites “measuring a response of one or more of the cable and the transmitter coil to the test signal, and evaluating the measured response of the one or more cable and transmitter coil, and ignores dependent claim 52, which recites “rectifying and smoothing the voltage induced in the receiver coil, and determining whether the rectified and smoothed voltage falls within a design specification range for the transmitter coil.” Clearly, these claims “have elements for evaluating whether the device is operational,” as is asserted in the Office Action as being needed for a finding of definiteness.

11. Withdrawal of the rejections is requested, and Applicants request that in the event that the claims are again rejected as indefinite, the PTO cite some form of controlling authority,¹ where a claim term/phrase was indefinite in a case having analogous facts to those at hand.

Dependent claims

12. The dependent claims incorporate all the subject matter of their respective independent claims and add additional subject matter which makes them independently patentable over the art of record. Accordingly, Applicants respectfully assert that the dependent claims are also allowable over the art of record.

¹ For example, a section of the MPEP, case law, or a Board of Appeals decision.

Conclusion

13. In view of the foregoing, this application should be in condition for allowance. A notice to this effect is respectfully requested.
14. Applicants reserve the right to pursue any cancelled claims or other subject matter disclosed in this application in a continuation or divisional application. Any cancellations and amendments of above claims, therefore, are not to be construed as an admission regarding the patentability of any claims and Applicants reserve the right to pursue such claims in a continuation or divisional application.

Dated: July 28, 2010

Respectfully submitted,

Electronic signature: /Michael G. Verga/
Michael G. Verga
Registration No.: 39,410
CONNOLLY BOVE LODGE & HUTZ LLP
1875 Eye Street, NW
Suite 1100
Washington, DC 20006
(202) 331-7111
(202) 293-6229 (Fax)
Attorney for Applicants